

APPLICANT(S): LEWKOWICZ, Shlomo et al.  
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### REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicant asserts that the present invention is statutory, new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

### Status of Claims

Claims 73-77, 88 and 89 are pending in the application, as a result of Applicant's election in the Response dated February 16, 2007 to prosecute those claims, following the Examiner's restriction of the application to one of two inventions, Group I containing claims 78-87 and Group II containing claims 73-77, 88 and 89. Claims 78-87 have previously been withdrawn. No amendments to the claims are being made herein.

### Claim Rejections

In the Office Action, the Examiner maintained his previous rejection of claims 73-77, 88 and 89 under 35 U.S.C. § 103(a), as being unpatentable over International Patent Application Publication No. WO 01/53792 to Given Imaging Ltd. in view of Japan Patent Publication No. 05200015 to Ueda et al. Applicants traverse the Examiner's rejection.

Applicants contend that WO 01/53792 is not available to be used as a reference against Applicants' application, under 35 U.S.C. § 103(c), which states as follows:

"(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person."

Applicants believe that WO 01/53792 qualifies as a reference against this application only under 35 U.S.C. § 102(e) and that the subject matter of WO 01/53792 and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person, namely Given Imaging Ltd.

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With respect to the critical reference date of WO 01/53792, Applicants note that the publication date of WO 01/53792 is July 26, 2001. However, the present application, while filed January 16, 2002, claims priority under 35 U.S.C. § 119(e) from U.S. Provisional Patent Application No. 60/261,189, filed January 16, 2001, which is prior to the publication date of WO 01/53792. Thus, WO 01/53792 is not prior art under § 102(a) or § 102(b).

Under M.P.E.P. § 2136.03(II), if the reference resulted from an international application that was filed on or after November 29, 2000, designated the United States and published under PCT Article 21(2) in English, then the international filing date is a U.S. filing date for prior art purposes under 35 U.S.C. § 102(e). If such an international application properly claims priority to an earlier-filed U.S. provisional application, apply the reference under 35 U.S.C. § 102(e) as of the earlier filing date. In this case, WO 01/53792 resulted from International Patent Application No. PCT/IL01/00053, filed January 18, 2001, claiming priority from U.S. Provisional Patent Application No. 60/487,337, filed January 19, 2000. Thus, assuming that the subject matter relied upon in the rejection was disclosed in U.S. Provisional Patent Application No. 60/487,337 in compliance with 35 U.S.C. § 112, first paragraph, WO 01/53792 is prior art to the present application as of January 19, 2000 under 35 U.S.C. 102(e).

Applicants point out to the Examiner that an applicant of WO 01/53792 is Given Imaging Ltd. Applicants point out to the Examiner that the present application is also assigned to Given Imaging Ltd., the assignment for which is recorded at the USPTO on April 18, 2002 at Reel 012815, Frame 0683, and the inventors of this application were under an obligation to assign the invention to Given Imaging Ltd. by virtue of their employment. Thus, the subject matter of WO 01/53792 and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. Accordingly, under 35 U.S.C. § 103(c), the subject matter of WO 01/53792 shall not preclude patentability of the present claims.

Accordingly, the rejection of claims 73-77, 88 and 89 under 35 U.S.C. § 103(a) should be withdrawn.


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In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,

  
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